

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 1-4 and 7-10 are active in the application subsequent to entry of this Amendment.

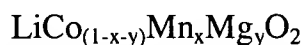
As a preliminary matter, attention is directed to the Information Disclosure Statement filed December 9, 2003 forwarding the results of a European Search Report. Please take this Information Disclosure Statement into account when further examining the claims of this application. No additional fee is required as it has been submitted within three months of the mailing of the Search Report.

Responding to the rejections and objections stated in the examiner's Letter, in item 1 counsel affirms the election of the subject matter of claims 1-4 and 7-10. Non-elected claims 5 and 6 have been deleted without prejudice to a divisional application directed to the subject matter of these claims or having these claims rejoined once the claims currently under examination are found to be allowable.

A revised Abstract of the Disclosure has been provided responsive to item 3 of the examiner's Letter.

In items 4-7 of the Official Action, claims 4 and 7 are criticized for failing to particularly point out and distinctly claim that which applicants regard as their invention. Claim 4 has been amended to refer only to y and claim 7 is amended to be fully independent and not refer back to a previous claim, either elected or non-elected.

Applicants' claims are directed to a cathode active material for a non-aqueous electrolyte secondary cell which has a c-axis length of lattice constant of 14.080 to 14.160 Å, an average particle size of 0.1 to 5.0 µm, and a composition represented by the formula:



in which x is a number of 0.008 to 0.18 and y is a number of 0 to 0.18.

An object of the invention is to provide a cathode active material for a non-aqueous secondary cell not only having an excellent initial discharge capacity but also exhibiting excellent charge/discharge cycle characteristics under high temperature conditions.

The Official Action contains three separate rejections of which various claims are rejected as allegedly being anticipated by the disclosures of three separately applied documents; see items 9-11 of the Action.

To anticipate a claim, a single reference must disclose the claimed invention with sufficient clarity to prove its existence in the prior art. *Motorola Inc. v. Interdigital Technology Corp.*, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Anticipation rejections are only proper when the "claimed subject matter is identically disclosed or described in 'the prior art,' without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972); *see also Akzo N.V. v. International Trade Commission*, 1 USPQ 2d 1241, 1246 (Fed. Cir. 1986); *Ex parte Lee*, 31 USPQ 2d 1105, 1108 (BPAI 1993). Every element of the challenged claim must be disclosed within this single reference. *PPG Industries Inc. v. Guardian Industries Corp.*, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996). Absence from the reference of any claimed element negates anticipation *Kloster Speedsteel AB v. Crucible Inc.* 23 USPQ 160 (Fed. Cir. 1986).

Thus, applicants' claims are patentable over each of the cited references since they each fail to disclose each element of applicants' claims.

In each of these separate rejections it is acknowledged that "the specific lattice constant, BET specific surface area and crystallite size are inherent because the prior art product *seems to be identical* except that the prior art is silent as to such inherent characteristics" (emphasis added) reference being made to MPEP §2112. This passage of the MPEP also acknowledges that rejections of alleged anticipation may be rebutted by evidence showing that the prior art products do not necessarily process the characteristics

of the claimed product¹ and this is exactly the reason the attached Declaration of Inventor Maeda made January 20, 2004 is being submitted.

The evidence provided by Mr. Maeda shows that the cathode active material disclosed in European Patent No. 1 154 503, Japanese Patent Publication (KOKAI) 4-237968 and Japanese Patent Publication (KOKAI) 11-67209 is different from that of applicants' claims.

More specifically, the oxide composite particles obtained in Experiment 1 (Japanese Patent Publication (KOKAI) 11-67209) have a c-axis length of lattice constant of 14.078 Å, the powders obtained in Experiment 2 (European Patent No. 1 154 503) have a c-axis length of lattice constant of 14.069 Å, and the positive electrode active material obtained in Experiment 3 (Japanese Patent Publication (KOKAI) 4-237968) has a c-axis length of lattice constant of 14.078 Å, all of which are out of the range of applicants' claims.

Performance characteristics are also significantly different. As an illustration of this the capacity retention percentages after 50 cycles at 60°C of the secondary cells produced using the material obtained in Experiments 1 to 3 as a cathode active materials is 81% or less. See the second table on page 7 of Mr. Maeda's declaration. As a result, the secondary cells produced using the material obtained in Experiments 1 to 3 are inferior in capacity retention percentages after 50 cycles at 60°C as compared to secondary cells prepared using a product of the present invention.

Accordingly, one of ordinary skill in the art would not expect the cathode active material and non-aqueous electrolyte secondary cell as defined by applicants' claims from the disclosures of European Patent No. 1 154 50, Japanese Patent Publication (KOKAI) 4-237968 and Japanese Patent Publication (KOKAI) 11-67209.

¹ *In re Best*, 562 F.2d at 1255, 195 USPQ at 433 (CCPA 1977).

MAEDA et al
Appl. No. 09/994,903
February 4, 2004

Based upon the attached information and the above observations and comments, it will be apparent that applicants' claims are not anticipated by the disclosures of any of these three documents and that the rejections based upon them, items 9-11 of the Official Action, have been overcome and thus should be withdrawn.

Reconsideration and favorable action are requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____



Arthur R. Crawford
Reg. No. 25,327

ARC:eaw
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100